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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,483	04/13/2001	Kun Zhang	GEMS8081.081	7333
27061 7590 03/03/2009 ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS) 136 S WISCONSIN ST PORT WASHINGTON, WI 53074			EXAMINER DADA, BEEMNET W	
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In re Application of:
Zhang et al.
Application No. 09/681,483
Filed: April 13, 2001
For: METHOD AND SYSTEM TO REQUEST
REMOTELY ENABLED ACCESS TO
INACTIVE SOFTWARE OPTIONS
RESIDENT ON A DEVICE

DECISION ON PETITION
UNDER 37 C.F.R. 1.181

This is a decision on the petition filed June 9, 2008 under 37 CFR 1.181 (a)(3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

The Board of Patent Appeals and Interferences set forth a new ground of rejection rejecting claim 31 under 35 U.S.C. 101 on February 5, 2008. Petitioner appeals the refusal of the Examiner to enter amendments to claims 17, 19-24, 27 and 31.

In the BPAI decision, the Board did not address the rejections of claims 17, 19-23 and 31. See page 7, Appeal 2007-2568.

We note that Appellants have alleged that the Examiner erred in rejecting claims 17, 19, 21-23, and 31 under 35 U.S.C. 102(e) (App. Br. 5-8 and Reply Br. 3-5) and claim 20 under 35 U.S.C. 103(a) (App. Br. 8-9 and Reply Br. 6). However, because we find that Appellants have not shown that the Examiner erred in concluding that claims 17, 19-23, and 31 are nonstatutory subject matter, these claims are "barred at the threshold by 101". *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). For this reason we do not address the rejections of these claims under 35 U.S.C. 102(e) and 103(a).

The BPAI issued a new ground of rejection under 37 CFR 41.50(b). Claim 31 was rejected under 35 U.S.C. 101 for the same reasons as the sustained rejection of its base claim 17.

Petitioner filed newly amended claims 17, 19-24, 27 and 31 on April 7, 2008. The Examiner refused entry of the amendments on the grounds that "prosecution is closed" in the Office

Communication of May 9, 2008. Petitioner appeals the refusal of the entry of amendments and petitions for prosecution to be reopened.

MPEP 1214.01 states:

When the Board makes a new rejection under 37 CFR 41.50(b), the appellant, as to each claim so rejected, has the option of:

- (A) reopening prosecution before the examiner by submitting an appropriate amendment and /or new evidence (37 CFR 41.50(b)(1)); or
- (B) requesting rehearing before the Board (37 CFR 41.50(b)(2)).

The amendment and/or new evidence under 37 CFR 41.50(b)(1), or the request for rehearing under 37 CFR 41.50(b)(2), must be filed within 2 months from the date of the Board's decision. In accordance with 37 CFR 1.196(f), this 2-month time period may not be extended by the filing of a petition and fee under 37 CFR 1.136(a), but only under the provisions of 37 CFR 1.136(b), or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

If an appellant files an appropriate amendment or new evidence (see paragraph I below) as to less than all of the claims rejected by the Board under 37 CFR 41.50(b), and a request for rehearing (see paragraph II below) as to the remainder of the claims so rejected, the examiner will not consider the claims for which rehearing was requested. The request for rehearing will be considered by the Board after prosecution before the examiner with respect to the first group of claims is terminated. Argument as to any of the claims rejected by the Board which is not accompanied by an appropriate amendment or new evidence as to those claims will be treated as a request for rehearing as to those claims.

I. SUBMISSION OF AMENDMENT OR NEW EVIDENCE

37 CFR 41.50(b)(1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or new evidence relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims. *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). An amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate. The new claims will not be entered, and the examiner should return the application file to the Board for consideration of the amendment as a request for rehearing under 37 CFR 41.50(b)(2), if it contains any argument concerning the Board's rejection. The "new evidence" under the rule may be a showing under 37 CFR 1.130, 1.131 or 1.132, as may be appropriate.

If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, it will be treated as a request for rehearing under 37 CFR 41.50(b)(2).

The new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR 41.50(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 41.50(b) rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under 37 CFR 41.50(b) is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 41.50(b) rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 41.50(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered.

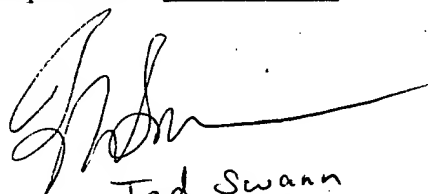
The BPAI initiated a new ground of rejection against claim 31 under 35 U.S.C. 101 for non-statutory subject matter. Petitioner amended claims 17, 19-24, 27 and 31 to overcome rejections under 35 U.S.C. 101 and to overcome the art rejection in the application.

The new ground of rejection entered by the BPAI under 37 CFR 41.50(b) was against claim 31 for purposes of rejecting statutory subject matter. MPEP 1214.01 states "the new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied." Petitioner's amendments to claims 17, 19-24, and 27 were not covered in the new ground of rejection under 37 CFR 41.50(b). **Petitioner's amendment to claim 31 were beyond the limited scope of the rejection of claim 31 under statutory subject matter. Therefore, Petitioner's amendment was not "an appropriate amendment" of the claims rejected by the board under 37 CFR 41.50(b).**

Petitioner may reopen prosecution under MPEP 1214.07. Petitioner could submit the amendment with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e).

It is noted that a second amendment after board decision has been submitted on the same day as the petition and will be forwarded to the examiner consideration.

For the above reasons, the petition is **DISMISSED**.


Tad Swann
DAS 2400